

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CUSTOMER NO. 22927

Appellants: Jay S. Walker, James Jorasch, Magdalena Mik
Application No.: 09/716,918
Filed: November 20, 2000
Title: ELECTRONIC AMUSEMENT DEVICE AND METHOD
FOR ENHANCED SLOT MACHINE PLAY

Attorney Docket No.: 98-010X

Group Art Unit: 3714
Examiner: Leiva, Frank M.

REPLY BRIEF

**BOARD OF PATENT APPEALS
AND INTERFERENCES**

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Appellants hereby submit remarks in this Reply Brief pursuant to 37 C.F.R. § 41.41 and in response to the Examiner's Answer mailed on November 28, 2008. This Reply Brief is submitted as a supplement to the Appeal Brief mailed on July 8, 2008 and should, if applicable, be considered as a request to maintain the current appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner in the Final Office Action mailed January 8, 2008 (Part of Paper No./Mail Date 20071220), rejecting claims **50-77**.

STATUS OF CLAIMS

Claims **50-77** are pending in the present application.

Claims **50-77** are being appealed.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims **50-54, 56-58, 60-62, 64-69 and 71-77** stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Barrie (U.S. Patent No. 5,833,537). Claim **70** is rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Barrie.

REMARKS

I. No New Grounds for Rejection

Appellants note that the Examiner has not, in the Examiner's Answer mailed on November 28, 2008 (hereinafter the "Examiner's Answer"), altered or added any grounds of rejection with respect to the claims being appealed. Accordingly, this Reply Brief is submitted voluntarily pursuant to 37 C.F.R. § 41.41.

II. Incorrect Interpretation

With regards to claims **57 and 58**, Appellants respectfully assert that the Examiner repeatedly misconstrues the teachings of Barrie.

Specifically, the Examiner asserts "Barrie columns 5 lines 5-8, '*For example, it may be desired to remove a persistent symbol after it has remained in place for a predetermined number of rounds of the game*', lines 33-37, '*For example, a persistent symbol can be added in response to the passage of a certain amount of time or play of a certain number of rounds, without the appearance of the persistent symbol in a given position*', and lines 44-47, '*Other types of delete events can be used, such as the passage of a certain amount of time or play of a certain number of games, a period of time without any game play, a new player initiating play ...*' where the bonus pay that is dependent on the number of persistent tracked symbols are dependent on amount of play, number of rounds or a certain number of games. Since the bonus amount is dependent on the persistent symbols and they depend on a number of plays or games, then the bonus payout is

also dependent on the, or based on the number of plays.” (italics in original)(Examiner’s Answer, page 7).

Appellants note that, following the citations quoted above, the Examiner proceeds to erroneously paraphrase the preceding citations. The Examiner then continues by subjecting the paraphrased assertion to a crucible of misleading reasoning resulting in its transmogrification into a seemingly reasonable assertion. However, a cursory examination of the teachings of Barrie makes readily apparent the underlying fallacy in the Examiner’s interpretation of Barrie.

Appellants commence by noting that the Examiner’s selective citation to column 5, lines 5-8 of Barrie omits disclosures which render the Examiner’s assertions erroneous. Specifically, at col. 4, line 62 - col. 5, line 23, Barrie states the following:

In the depicted embodiment, the memory includes an array 234 having memory locations 236a, 236b, 236c, associated with each of the play position 188a through 118i of the play field 114. In this embodiment, the memory 216 can be used to indicate that a persistent symbol 124 should be displayed at a position of the play field 114 by storing a predetermined value or values in the corresponding memory location 236a through 236i. In one embodiment, the value stored may be a logical true/false value. In another embodiment, however, it may be desired to include an indication of the age of a persistent symbol. **For example, it may be desired to remove a persistent symbol after it has remained in place for a predetermined number of rounds of the game.** In an embodiment in which it is desired to retain a persistent position for no more than five successive rounds, the system can be configured such that a value of zero in a memory location means that no persistent symbol is to be displayed in the corresponding play field position, and such that a value of five is stored in the corresponding memory location whenever a persistent symbol is first positioned at a location of the play

field. Thereafter, each time a round is played, the values of all non-zero, positive memory locations in the array 234 may be decremented by one. In this fashion, a persistent symbol will be removed after five games. If desired, the display 112 may be configured to include an indication of the age of a persistent symbol, such as by initially showing a persistent symbol in a vivid color or contrast and successively diminishing or fading the color or contrast of the persistent symbol for each successive round until it finally disappears or is removed. (Examiner's citation bolded).

As is evident, Barrie discloses a memory forming an array of integer values. These values may each assume a logical true/false value (typically represented by the Boolean values 0 and 1) in which case the values indicate whether a persistent symbol should be displayed at a position corresponding to each individual value. Conversely, each value may store an integer value that is decremented until it reaches a value of zero at which point a persistent symbol is no longer displayed at a position corresponding to value.

As is therefore evident, Barrie nowhere discusses the storage of any value corresponding to a “number of persistent tracked symbols” as the Examiner asserts, or the number of occurrences of a tracked symbol (however defined). Rather, Barrie discloses a memory containing values indicating whether a persistent symbol is to be displayed at a predefined position, and, in some cases, how much longer to continue to display the persistent symbol.

The Examiner is therefore incorrect when asserting, via a paraphrasing of the teachings of Barrie, “where the bonus pay that is dependent **on the number of persistent tracked symbols** are dependent on amount of play, number of rounds or a certain number of games.” (emphasis added). As a result, the Examiner is in error when continuing by asserting “Since the bonus amount is dependent on the

persistent symbols and they depend on a number of plays or games, then the bonus payout is also dependent on the, or based on the number of plays.” Appellants note that, in this, the Examiner’s final formulation, the phrase “dependent on the number of persistent tracked symbols” has been neutered to simply state “dependent on the persistent symbols”.

Appellants respectfully submit that the generic reference to “persistent tracked symbols” is intended to subsume the more particular “number of persistent tracked symbols” which, as described above, is an erroneous description of the teachings of Barrie. Appellants further note that the same reasoning discussed herein with reference to claim **57** is equally applicable to the examiners assertions regarding claim **58**. (Examiner’s Answer, pages 7-8).

With respect to claim **72**, Appellants respectfully assert that the Examiner repeatedly misconstrues the teachings of Barrie.

The Examiner states that “Specifically, Barrie neither teaches nor suggests: *determining a count value wherein the count value is incremented when there is an occurrence of the at least one tracked symbol and the count value is decremented when an occurrence of the at least one tracked symbol expires, such that the count value may be a non-zero integer after the count value is decremented upon an expiration of an occurrence.* The examiner points to column 7 lines 5-12, where the prize or point value of a bank symbol is incremented for the appearance of the tracked symbol”. (Examiner’s Answer, page 8).

Appellants note that, in fact, at col. 7, lines 5-12, Barrie states:

If a bank symbol 624a,b,c lands on a reel position bearing a persistent coin symbol 611, the prize or point value associated with progressive game bank

symbol 622 aligned with the payline where the bank symbol 624 landed is incremented. If desired, incrementation of values associated with wanted posters 614 and/or banks 622 may be animated, such as by depicting an image of a coin traveling from a reel position to a wanted poster 614 or bank 622 image.

Appellants respectfully assert that the Examiner is incorrect in his description of the teachings of Barrie. First, it seems apparent that the Examiner is interpreting the bank symbol of Barrie to be the claimed tracked symbol. However, as Barrie makes clear, no count value is incremented when the bank symbol appears. At most, Barrie discloses incrementing a prize or point value when the bank symbol appears **and** its appearance coincides with “a reel position bearing a persistent coin symbol.” Furthermore, Appellants note that claim **72** recites a tracked *symbol having an associated expiration condition wherein an occurrence of the at least one tracked symbol expires upon the associated expiration condition becoming satisfied*. Assuming, once again, that the bank symbol is the tracked symbol, there is no teaching in Barrie of any expiration condition associated with the occurrence of the bank symbol as claim **72** requires.

III. Conclusion

At least for the above-stated reasons, in supplement to those submitted and described in the Appellants' Appeal Brief, Appellants respectfully request that the Examiner's rejections of the pending claims be reversed.

Applicants do not believe an extension of time to make this Amendment and Response timely is necessary. However, should an extension of time be necessary, please grant a petition of an extension of time necessary to make this submission timely. Additionally, please charge any fees that may be required for this submission as follows:

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Respectfully submitted,

January 28, 2009
Date

/Magdalena M. Fincham, 46,085/
Magdalena M. Fincham
Attorney for Applicant
Registration No. 46,085
mfincham@walkerdigital.com
203-461-7041/voice
203-461-7300/fax